| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/595,741 | 06/16/2000 | Terri Sorge | 13237-2580 MS #149442.1 | 1660 |

7590      08/14/2003

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| EXAMINER |
|---|
| BLAIR, DOUGLAS B |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2142 | |

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/595,741 | SORGE ET AL. |
| | **Examiner** | **Art Unit** |
| | Douglas B Blair | 2142 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _16 June 2000_ .

2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-49_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-49_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-13, 19-23, 25-31, 37-38 and 40-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,405,225 to Apfel et al.. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims in this application are broad enough to include the subject matter claimed in U.S. Patent No. 6,405,225.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 19, the preamble of the claim lacks a subject. The claim describes something

that is being "in or for a computer system" however the claim fails to describe what that

something is.

## *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5, 12, 19-20, 22-23 and 30 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Patent Number 6,529,942 to Gilbert.

As to claim 19, Gilbert teaches a computer system comprising a processing unit, a user

input device coupled to the processing unit, a memory coupled to the processing unit, a display

device coupled to the processing unit, and an application program running on the processing unit,

for sending a pre-selected portion of a document to a recipient via electronic mail, operable to

perform the steps: receiving a pre-selected portion of a document (col. 4, lines 54-67 and col. 5,

lines 1-5); receiving a command to send the pre-selected portion of the document to a recipient

via electronic mail (col. 5, lines 6-18); and in response to receiving the command to send the pre-

selected portion of the document, coding the pre-selected portion of the document for

transmission via electronic mail (col. 5, lines 6-26), and sending the coded pre-selected portion

of the document to recipient via electronic mail (col. 5, lines 27-46).

As to claim 20, Gilbert teaches the computer system of claim 19, further comprising the

steps of: determining content in the pre-selected portion of the document (col. 7, lines 7-34); and

in response to determining the content, changing a user interface to correspond with the content

(col. 7, lines 7-34).

As to claim 22, Gilbert teaches the computer system of claim 19, wherein the step of

sending the coded pre-selected portion of the document to the recipient via electronic mail

comprises the steps of: launching an electronic mail application program; and inserting the coded

pre-selected portion of the document into an e-mail message (col. 7, lines 7-34).

As to claim 23, Gilbert teaches the computer system of claim 20, wherein the command

to send the pre-selected portion to a recipient via electronic mail is received through the user

interface (col. 7, lines 7-34).

As to claim 30, Gilbert teaches the computer system of claim 19, wherein the document

comprises a spreadsheet document or file (col. 4, lines 54-67 and col. 5, lines 1-25).

As to claim 1-2, 4-5, and 12, they have limitations that correspond to those of claims 19-

20, 22-23 and 30, respectively, and are thus rejected on the same basis as claims 19-20, 22-23,

and 30.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 6-8, 11, 13-14, 16-18, 24-26, 29, 31-32, 34-36, 37, 39-41, 44-45, and 47-49 are

rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to

Gilbert in view of U.S. Patent Number 6,157,934 to Khan et al..

As to claim 25, Gilbert teaches the computer system of claim 19; however, Gilbert does

not explicitly teach a document comprising a single cell or multiple cells.

Khan teaches coding a spreadsheet with cells as a document for manipulation via email

(col. 2, lines 4-29).

It would have been obvious to one of ordinary skill in the Computer Networking art to

combine the teachings of Gilbert regarding the transfer of information via email with the

teachings of Khan regarding coding of spreadsheets for manipulation via email because

distributed spreadsheet manipulation simplifies business processes (Khan, col. 1, lines 15-29).

As to claim 26, since a spreadsheet features tables claim 26 is rejected for the same

reasons as claim 25.

As to claims 29 and 36, they are rejected for the same reasons as claim 25.

As to claims 7, 8, 11, 18 and 49, they feature the same limitations as claims 25, 26, 29

and 36, respectively, and are thus rejected on the same basis as claims 25, 26, 29 and 36.

As to claim 37, Gilbert teaches a computer-readable medium with instructions for

automatically sending a pre-selected portion of a spreadsheet document to a recipient, having

computer-executable instructions comprising: receiving a pre-selected portion of a document

(col. 4, lines 54-67 and col. 5, lines 1-5); determining content in the pre-selected portion of the

document (col. 7, lines 7-34); in response to determining the content, changing a user interface to

correspond with the content (col. 7, lines 7-34); receiving a command through the user interface

to send the pre-selected portion of the document to a recipient via electronic mail (col. 7, lines 7-34); in response to receiving the command to send the pre-selected portion of the document, coding the pre-selected portion of the document for transmission via electronic mail (col. 5, lines 6-26), launching an electronic mail application program, and inserting the coded pre-selected portion of the document into an e-mail message (col. 7, lines 7-34); detecting a command to apply a control to the pre-selected portion of the document; in response to receiving a command to apply a control to the pre-selected portion, coding a control or the pre-selected portion, and inserting the coded control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the control to the pre-selected portion (col. 5, lines 6-26); and sending the coded pre-selected portion of the document an the control to the recipient via electronic mail (col. 5, lines 27-46); however Gilbert does not explicitly teach an interactive control.

Khan teaches detecting a command to apply an interactive control to the pre-selected portion of the document; in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control or the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion; and sending the coded pre-selected portion of the document an the interactive control to the recipient via electronic mail (col. 2, lines 4-60, the clients have interactions with the spreadsheets).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gilbert regarding the transfer of information via email with the teachings of Khan regarding coding of interactive spreadsheets for

manipulation via email because distributed spreadsheet manipulation simplifies business

processes (Khan, col. 1, lines 15-29).

As to claims 13 and 14, they feature limitations that are present in claim 37 and are

therefore rejected for the same reasons as claim 37.

As to claims 31 and 32, they feature limitations that are present in claim 37 and are

therefore rejected for the same reasons as claim 37.

As to claim 39, Khan teaches a user interface comprising a send button that corresponds

to content of the pre-selected portion of the document and changes in response to the content of

the pre-selected portion (col. 7, lines 39-67 and col. 8, lines 1-8).

As to claims 6 and 24, they feature the same limitation as claim 39 and are rejected for

the same reasons as claim 39.

As to claims 40, 41, and 44-45, they feature the same limitations as claims 25, 26 and 29-

30, respectively, and are thus rejected for the same reasons as claims 25, 26 and 29-30.

As to claim 47, Khan teaches an interactive control which comprises information to

enable a recipient viewing the content of the pre-selected portion to manipulate the content (col.

6, lines 12-26).

As to claim 48, Khan teaches an interactive control comprising filtering, sorting,

calculating, pivoting, and charting functions (col. 6, lines 12-26, such functions are all standard

spreadsheet functions.).

As to claims 16 and 17, they feature the same limitations as claims 47 and 48,

respectively, and are rejected for the same reasons as claims 47 and 48.

As to claims 34 and 35, they feature the same limitations as claims 47 and 48, respectively, and are rejected for the same reasons as claims 47 and 48.

Claims 3, 9-10, 21, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 5,748,188 to Hu et al..

As to claim 21, Gilbert teaches the computer system of claim 19; however Gilbert does not explicitly teach coding a document with HTML.

Hu teaches coding a pre-selected portion of a document in HTML that is to be e-mailed to a client (col. 10, lines 48-65).

It would have been obvious to one of ordinary skill in the Computer Networking art to combine the teachings of Gilbert regarding the transfer of information via email with the teachings of Hu regarding the coding of a document with HTML because HTML is commonly used to describe any particular organization of information (Hu, col. 1, lines 24-32).

As to claim 27, Gilbert teaches the computer system of claim 19; however Gilbert does not explicitly teach the inclusion of a chart.

Hu teaches the inclusion of a chart in a document to be e-mailed to a client (col. 22, lines 64-67).

It would have been obvious to one of ordinary skill in the Computer Networking art to combine the teachings of Gilbert regarding the transfer of information via email with the teachings of Hu regarding the inclusion of a chart because a chart is a common way to convey data to a user.

As to claim 28, a chart is considered a graphic therefore claim 27 is rejected for the same reasons as claim 27.

As to claim 3, 9, and 10 they feature the same limitations as claims 21, 27 and 28 and are rejected on the same basis as claims 21, 27 and 28.

Claims 12 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert.

As to claim 30, Gilbert teaches the computer system of claim 19, wherein the document comprises a spreadsheet document or file; however Gilbert does not explicitly teach the use of a word processing document.

Claims 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 6,542,923 to Nguyen.

As to claim 33, Gilbert teaches the computer system of claim 19; however Gilbert does not teach the use of ActiveX.

Nguyen teaches the use of ActiveX controls for use in a system for emailing content (col. 2, lines 53-67).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gilbert regarding the transfer of information via email with the teachings of Nguyen because ActiveX programs provide a convenient way to provide interaction (Nguyen, col. 1, lines 9-42).

As to claim 15, it features the same limitation as claim 33 and is rejected for the same reasons as claim 33.

Claims 38 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 6,157,934 to Khan et al. as

applied to claim 37 above, and further in view of U.S. Patent Number 5,748,188 to Hu et al..

As to claim 38, 42, and 43 they feature the same limitations as claims 21, 27 and 28 and

are rejected for the same reasons as claims 21, 27 and 28.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

Number 6,529,942 to Gilbert in view of U.S. Patent Number 6,157,934 to Khan et al. as applied

to claim 37 above, and further in view of U.S. Patent Number 6,542,923 to Nguyen.

As to claim 46 it features the same limitations as claim 33 and is rejected for the same

reasons as claim 33.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267.  The

examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mark  Powell can be reached on 703-305-9703.  The fax phone numbers for the

organization where this application or proceeding is assigned are 703-746-7239 for regular

communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair
August 5, 2003
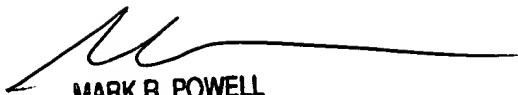
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